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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,766	10/31/2001	Yoshizumi Mano	09812.0171-00000	4322
22852 7590 02/11/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER RUHL, DENNIS WILLIAM	
			ART UNIT 3629	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/001,766

## Applicant(s)

MANO ET AL.

## Examiner

Dennis Ruhl

## Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's amendment of 11/14/07 has been entered. Currently claims 1-9 remain pending and claims 10-15 remain non-elected and withdrawn. The examiner will address applicant's remarks at the end of this office action.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 3, there is no antecedent basis for "the information process system". Is this another system in addition to the claimed "information processing system"? This is not clear.

For claim 7, there is no antecedent basis for "the purchase-and-sale contract". What is this referring to? No contract of any kind has been previously recited in the scope of this claim.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferstenberg et al. (5873071).

For claim 1, Ferstenberg discloses a system and method for the sale of commodities. Ferstenberg discloses an intermediary system 40 (a computerized system; i.e. a server) that allows buyers and seller of a commodity to interact and negotiate with each other concerning the purchase of the commodity. The intermediary system receives information from sellers of commodities and allows buyers to view the information received from sellers. The commodity that is being sold can be anything from stocks and bonds to tangibles such as copper or soy beans, see column 1, lines 14-25. With respect to the limitation that the data to be received is "media content information", this is directed to non-functional descriptive material that does not define any structure to the system being claimed. The data that is to be received has nothing to do with the structure of the claimed elements that actually receive the data. The limitation of "media content information" is directed to the intended use of the system that does not result in a structural difference from that of the prior art. Ferstenberg discloses that there are seller computers and buyer computers, which are the client systems disclosed in column 39. Each client system is connected via a network to

intermediary system 40. The claimed input means is considered to be the hardware and software that the system 40 would necessarily be required to have so that data can be received from a seller. This can be a modem and the software that allows data to be received. The intermediary system 40 inherently has an input means. It must have an input means so that the system can receive data from the sellers and buyers of various commodities as disclosed by Ferstenberg. The recording means is considered to be the database of the system 40 and the software that controls the saving of data. This is also inherent to the system 40. The claimed output means is the hardware and software that allows system 40 to send out communications to the clients. For system 40 to be able to send communications to the client systems, an output means is necessarily required. The *settling means* that is for settling a "purchase-and-sale contract" is considered to be the hardware and software that allows the negotiation between the seller and buyer to occur, which results in the a sale occurring. The act of negotiation is done to allow a contract for sale to be arrived at and once that is accomplished, a contract is the result. This satisfies what is claimed. With respect to the fact that claim 1 is reciting that the information received is concerning "media content information" and that the input means is further operable to receive 2nd information indicating purchase rights, as stated previously, this has been considered but as far as the system goes, this defines nothing to the system that is not found in Ferstenberg and is directed to the intended use of the system. This is because the commodity that is being sold is not part of the system and claiming a specific commodity does not change the overall system. The system of Ferstenberg and the input means of

Ferstenberg is fully capable of receiving the claimed kind of information. Because Ferstenberg can be used with any kind of commodity and because the system is what is being claimed in claim 1 (not the method), Ferstenberg anticipates what is claimed. The recitation that it is "media content information" that is being sold does not result in a structurally different system from that of Ferstenberg. The output means is fully capable of being able to transmit information about a purchase-and-sale contract to another person (escrow agent). This is another recitation directed to just the ability of the output means to be able to transmit certain types of information, something that is found in Ferstenberg. The same is true for the recording means. The recording means can record whatever data one wants to record. These recitations define nothing further to the system that is not found in Ferstenberg and are directed to the intended use of the system as far as what data applicant intends to use the system with.

For claim 2, the negotiation aspect of Ferstenberg results in the formation of and storage of a document (the transmitted offers and counteroffers) regarding the sale of the commodity. This satisfies what is claimed.

For claim 3, the input means is fully capable of receiving the claimed information as was discussed with respect to claim 1. It is considered inherent to Ferstenberg that there is a "search means" that will search for matching information that matches the information submitted from the buyer. This is necessarily present in Ferstenberg because when a buyer submits an order for a particular commodity, the system 40 must have some way of determining what clients can satisfy the order desired by the buyer. This is how the matching of a selling client to a buying client happens. The outputs

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means has already been addressed with respect to claim 1. The system 40 cannot assist in the conducting of a transaction if it cannot be determined who has offered a particular commodity for sale that a buyer has expressed an interest in purchasing. As stated previously, the kind of data intended to be received or outputted by various claim elements is directed to the intended use of the system and is considered to be non-functional descriptive material that does not serve as a limitation.

For claim 4, the input means are satisfied by the input means discussed with respect to claim 1. The system 40 stores information concerning the sellers and buyers that interact with system 40, which satisfies what is claimed with respect to the recording means.

For claim 5, this claim is reciting nothing further structurally to the system of claim 1. This is because the "media content rights" are not a structural part of the system. The rights are just what the system is used to sell. Additionally, "rights" are not even a real world tangible thing that can be claimed, so the examiner cannot possibly give weight to what is claimed. A "right" is not a real world thing, but is more of an intangible thing. Claim 5 is directed to non-functional descriptive material.

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferstenberg et al. (5873071).

For claims 6-9, Ferstenberg discloses a system and method for the sale of various commodities. Ferstenberg discloses an intermediary system 40 (a computerized system; i.e. a server) that allows buyers and seller of a commodity to interact and negotiate with each other concerning the purchase of the commodity. The intermediary system receives information from sellers of commodities and allows buyers to view the information received from sellers. The commodity that is being sold can be anything from stocks and bonds to tangibles such as copper or soy beans, see column



1, lines 14-25. Ferstenberg discloses that there are seller computers and buyer computers, which are the client systems disclosed in column 39. Each client system is connected via a network to intermediary system 40. The claimed receiving first content is considered to be satisfied by the fact that data is received from a seller regarding what commodities are for sale (column 17, lines 51-63). This information is recorded as claimed. The claimed outputting step is the sending of information to the buyer. This would be information regarding what the seller is selling and would be notification to the buyer that a transaction may be able to be made. The settlement step is disclosed in step 14 of Ferstenberg. Ferstenberg disclose that negotiation between the seller and buyer occurs by the transmission of offers and counter offers. The act of negotiation is done to allow a contract for sale to be arrived at and once that is accomplished, a contract is the result. The act of viewing offers and counter offers satisfies the claimed viewing of web pages as claimed. The offers and counter offers are messages as claimed.

With respect to the fact that the claim is reciting that the information received is concerning "media content", this is not disclosed by the prior art. Also not disclosed is that information is received indicating the purchase rights of the media content and that information about the delivery of the media content is recorded (claims 6,7). Also not disclosed is the limitation of transmitting information about the purchase and sale contract to an escrow agent (claims 6,7).

Because it is disclosed that the commodities can be stocks and bonds, or real world tangible goods (copper), one of ordinary skill in the art would have recognized that

the system of Ferstenberg could be used for the selling and buying of any kind of commodity. Because it is very well known in the art to one of ordinary skill in the art that "program content" (broadcasting rights for some kind of media content) is sold by "content producers" and that content is purchased by "broadcasters", one of ordinary skill in the art at the time the invention was made would have found it obvious to use the system of Ferstenberg for the sale and purchase of television programming rights. This is just using the Ferstenberg for another type of commodity that is widely recognized as already being bought and sold by those involved in television and the media. When one is selling media content, it is considered inherent that there is information indicating what the actual rights are that are being purchased. The rights that are claimed as being received are necessarily involved in the selling of broadcast rights for media content, as is very well known in the art. With respect to the recording of information about the delivery of the media content, it would have been obvious to record that fact that the buyer has actually received the media content (this can be the recording of the fact that the transaction has occurred and has been completed). This would have been obvious. With respect to the claimed limitation of transmitting "information about" the purchase and sale contract to an escrow agent, this limitation is directed to non-functional descriptive material that does not serve as a limitation. The claimed "information about" is broad language and is not reciting that any specific type of information is being transmitted. Also, this information is never even used in any further manipulative step and because of this fact patentably distinguishing weight will not be given to data that is just transmitted but never used in any further step.

Also and as an alternative interpretation to the limitation of transmitting "information about", it is very well known in the art of contracts that escrow accounts are used when sellers are selling various items to a buyer. A third party holds an escrow account and upon the fulfillment of certain conditions will release the content of the account. Escrow accounts and escrow agents are very well known in the art. The examiner takes official notice of this fact. One of ordinary skill in the art at the time the invention was made would have found it obvious to use an escrow agent with an escrow account, because it is commonplace to use a third party (escrow agent) when dealing with sales of items subject to contract conditions.

For claim 7 in addition to that above, when a program is sold by using the system of Ferstenberg, this is "attaching" the "right" to broadcast the purchased media content to the content itself. When a buyer negotiates the purchase of media content by using the system of Ferstenberg, and a sale is made, this is a granting of the "right" for the buyer to broadcast the purchased media content. This satisfies what is claimed. Also, when purchasing commodities (broadcast rights), a request is received from the buyer as claimed that identifies the media content that they wish to purchase. With respect to the limitation of receiving information about how the buyer wants to use the media content, this is another limitation directed to non-functional descriptive material that does not serve as a limitation. This information is never used at all in the claim and is only claimed as being received, which renders it as non-functional descriptive material.

9. Applicant's arguments filed 11/14/07 have been fully considered but they are not persuasive.

With respect to the 102(b) rejection in view of Ferstenberg, the arguments are not persuasive. Applicant has argued that the prior art does not disclose the claimed output means. The data that the output means is intended to output does not receive patentably distinguishing weight in apparatus type of claims. All that is claimed is the ability to output certain data ("operable to transmit"), something that Ferstenberg is fully capable of performing. In response to applicant's argument that the prior art does not disclose the ability to transmit the claimed information to an escrow agent, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The prior art satisfies what is claimed and the rejection will be maintained.

For claims 6,7, applicant has relied upon the arguments for claim 1, which are not persuasive. Claim 1 is an apparatus claim and claim 6 is a method claim. The newly added limitations have been addressed in the rejection of record, so applicant's arguments are moot.

For claim 9, a page is generated in the prior art that is viewable by the buyer and that displays a message input from the seller, just as claimed. This satisfies what is claimed in the opinion of the examiner. A page is a page, calling the page a web page that displays a message is not anything that distinguishes over the prior art, which does

the same thing. Clearly when electronic messages are exchanged, the messages themselves are displayed in a page, this satisfies what is claimed. The rejection will be maintained.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/

Primary Examiner, Art Unit 3629